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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,702	12/29/1999	EVAN HOWARD LOTT		1341

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EXAMINER
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CHANCE, JANET D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/473,702	Applicant(s) LOTT, EVAN HOWARD <i>h</i>	
	Examiner Janet D. Chance	Art Unit 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 6 September 2002. Claims 1-11 have been cancelled and claims 12-22 are pending.

### ***Drawings***

2. The corrected or substitute drawings were received on 6 September 2002. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

3. The 35 USC § 112 rejections are now withdrawn in light of the amendment filed 6 September 2002.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett et al. (5,325,291), and further in view of May (May, Jerrold, "A Hybrid system improves claims auditing at Blue Cross").

(A) Claim 12 differs from claim 1 addressed in the prior Office Action (paper number 6) in the recitation of a high degree of reliability "in excess of 95 percent of matching drivers/vehicles/policy." The prior Office Action addressed that Garrett teaches computer processing to generate a database of uninsured motorists, that May teaches statistical methods to test the accuracy of claims data, and the motivation to combine (paper number 6, page 6). However, the rejection of claim 1 in the prior Office Action did not address the specific limitation of greater than 95% matching. Garrett and May do not specify any quantitative accuracy values. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Garrett and May to include a specific matching percentage such as greater than 95 percent, with the motivation suggested by May of reducing the time required for auditing information and reducing errors in transmitted data (May; page 67, paragraph 1, lines 11-14).

(B) Claim 13 differs from claim 2 in the recitation of 96 percent "of all insurance records submitted for review". However, these changes do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner

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when applying prior art within the previous Office Action (paper number 6). As such, claim 13 is rejected under the same rational provided in the prior Office Action, and incorporated herein.

(C) Claims 15-16 were substituted to avoid the 35 USC § 112 objections to the claims made in the prior Office Action (paper number 6). However, these changes do not affect the scope and breadth of the claims as originally presented and /or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (paper number 6). As such, these claims are rejected under the same rational given in the prior Office Action, and incorporated herein.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of the New York State Department of Motor Vehicles (Anonymous, "Motor Vehicle Liability Insurance Reporting Implementation Guide", Version 1.0, 1 April 1999).

(A) Claim 14 was substituted to avoid the 35 USC § 112 objections to the claims made in the prior Office Action (paper number 6). However, these changes do not affect the scope and breadth of the claims as originally presented and /or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (paper number 6). As such, these claims are rejected under the same rational given in the prior Office Action, and incorporated herein

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7. Claims 17-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of Johnston (Johnston, Michelle Dally, "State Targets Scofflaw Drivers Database to Reveal Who Is Insured")

(A) Claims 17-18 were substituted to avoid the 35 USC § 112 objections to the claims made in the prior Office Action (paper number 6). However, these changes do not affect the scope and breadth of the claims as originally presented and /or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (paper number 6). As such, these claims are rejected under the same rational given in the prior Office Action, and incorporated herein

(B) Claims 20-21 differ from claims 9 and 10 with the recitation of "in excess of 95 percent of matching driver/vehicle/policy". This limitation has been addressed in the rejection of claim 12 above and, as such, claims 20-21 are rejected for the same reasons provided for that claim and incorporated herein.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of Bosco et al. (5,191,522).

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(A) Claim 19 was substituted to avoid the 35 USC § 112 objections to the claims made in the prior Office Action (paper number 6). However, these changes do not affect the scope and breadth of the claims as originally presented and /or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (paper number 6). As such, these claims are rejected under the same rational given in the prior Office Action, and incorporated herein

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett, May, and Johnston as applied to claim 21 above, and further in view of Deppa et al. (5,732,198).

(A) Claim 22 was substituted to avoid the 35 USC § 112 objections to the claims made in the prior Office Action (paper number 6). However, these changes do not affect the scope and breadth of the claims as originally presented and /or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (paper number 6). As such, these claims are rejected under the same rational given in the prior Office Action, and incorporated herein



***Response to Arguments***

10. Applicant's arguments filed 6 September 2002 have been fully considered but they are not persuasive. Applicant's arguments are addressed herein below in the order in which they appear in the 6 September 2002 response.

(A) In response to Applicant's concern that the Examiner has ignored the mandate of the modern case law which clearly and explicitly hold that in order for the references to be combined in that the references must explicitly teach or suggest every element of the combination as well as how to use such a combination, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223

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USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192

USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

As such, it is respectfully submitted that an explanation based on suggestions provided by the references noted in the prior Office Action and below, and/or logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action (paper number 6), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(B) In reference to the Applicant's arguments on pages 9-11 of the 6 September 2002 response with respect to the Garrett and May references, the Examiner respectfully submits that Applicant's statements appear to improperly describe the full teachings of Garrett and May. In particular Applicant argues:

1) "nothing in Garrett suggests placing the data fields in a driver database." However, as noted in the original office action (paper number 6) Garrett teaches each of the fields noted in the instant application and the copying of fields into a separate holding area. Further, it would be obvious to separate the data as decided in *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d 522 (CCPA 1961).

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2) "Garrett does not disclose any problems with the entering data input", "but assumes the accuracy of the inputted databases, which is subject to "garbage in/garbage out errors."

However, as noted in the original Office Action (paper number 6) and further in col. 2, lines 10-15, Garrett does teach problems with the data input and the performance of accuracy checks on the input databases.

3) As per the arguments that "Garrett does not disclose or suggest applicant's computer processing method to generate the uninsured motorist and vehicle databases", "or address accuracy problems with these types of databases". As noted in the original Office Action (paper number 6) the combination of Garrett and May were used to reject this limitation. Garrett teaches a computer processing method of generating uninsured motorists and May teaches the use of (heuristics) alternative statistical methods at different stages of problem solving for analyzing insurance data. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4) As per the arguments that "Nor do either Garrett or May disclose the percentage quantities ...of 96... 99... and 95.8." or that "Garrett does not disclose accuracy checks on the working database." It is respectfully submitted that Garrett does teach accuracy checks as noted in the prior Office Action. While it is true that none of the references disclose the exact percentages in the claims, it is respectfully submitted that the issue at hand is whether such a modification would have been obvious to one of ordinary skill in the art under 35 U.S.C. 103(a), and not whether the applied reference expressly teaches the disputed features. Since the

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references were applied under 35 U.S.C. 103(a) with respect to specific percentages, the Examiner respectfully submits that the skilled artisan motivated to generate optimal solution sets would have clearly found it obvious to utilize high percentage quantities as thresholds.

5) In response to applicant's argument that May is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, May teaches, by the applicant's own admission in the 6 September 2002 response, the use of insurance codes, processing sequences, reviews, and claims assessments. Examiner acknowledges that the uses of these items may be slightly different in health care as opposed to uninsured motorists, but that the purpose and problem being solved is the same. Both May and the instant application are concerned with data accuracy, matching to determine data accuracy, correction of inaccuracies, and verifying current insurance. As such, the May reference is in the same field or art of insurance and is pertinent to the particular problem of data accuracy, and thus is analogous art.

6) In response to the Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level or ordinary skill in the art at the time of the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d

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1392,170 USPQ 209 (CCPA). In this case reconstruction was based on support and motivation in the references themselves or from logical arguments and therefore, was proper.

(C) The arguments regarding claims 5 (renumbered claim 16), and 9 (renumbered claim 20) have been addressed in the discussion of the Garrett and May references.

(D) In reference to the Applicant's arguments on page 11 of the 6 September 2002 response with respect to the New York State Department of Motor Vehicles reference, the Examiner respectfully submits that Applicant's statements appear to improperly describe the full teachings of the reference. In particular, Applicant argues: that the New York State Department of Motor Vehicles "does not suggest statistical sampling" however, the reference is not used in this capacity as May is relied upon for this limitation. Further, the applicant argues that there is no motivation to combine, when motivation has been clearly articulated in the prior Office Action (paper number 6) on page 8, lines 1-5. As such, the rejection stands.

(E) In reference to the Applicant's arguments on pages 11-12 of the 6 September 2002 response with respect to the Johnston reference, the Examiner respectfully submits that Applicant's statements appear to improperly describe the full teachings of the reference. In particular Applicant argues that there is no motivation to combine when motivation has been clearly articulated in the prior Office Action (paper number 6) on page 9, lines 1-3. Further, Applicant argues: that Johnston "does not suggest statistical sampling" however, the reference is not used in this capacity as May is relied upon for this limitation. The remainder of the

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arguments are, again, an attack on the references individually which has been addressed above in this Office Action, or on limitations that have been addressed in the prior Office Action (paper number 6).

(F) As per the arguments regarding claim 9, Examiner respectfully submits that the references do provide the method steps and therefore the rejection of the "mean-plus-function" rejection is proper.

(G) In reference to the Applicant's arguments on page 12 of the 6 September 2002 response with respect to the Bosco reference, the Examiner respectfully submits that Applicant's statements appear to improperly describe the full teachings of the reference. Bosco does teach both the transmitting of reports outside of a closed system and the suggestion of improving the ease of distribution as cited in the prior Office Action (paper number 6). As such the rejection is proper.

(H) In reference to the Applicant's arguments on page 12 of the 6 September 2002 response with respect to the Deppa reference, Examiner respectfully submits that the hindsight argument has been addressed above and further that the applicant did not invent the electronic signal transfer of coded signals to a translator that converts coded signals into printer reports (a printer and printer driver), and that these structures clearly exist within the prior art and would have been with that knowledge generally available to one having ordinary skill in the art at the time of the invention. Further, the courts have held that even if a patent does not specifically disclose a

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particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

(I) In reference to the Applicant's arguments on page 13 of the 6 September response with respect to the affidavit, Examiner acknowledges that the court have made it clear that secondary considerations, such as commercial success or long-felt need, may be relied upon to establish the non-obviousness of an invention. However, it is respectfully submitted that commercial success and long-felt need are secondary considerations that the ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The affidavit under 37 CFR 1.132 filed 6 September 20002 is insufficient to overcome the rejection of claims 1-11 based upon obviousness as set forth in the last Office action for at least the reasons provided below. The Applicant argues that:

1) the fact of being the sole supplier of uninsured motor vehicle in the State of Utah is a clear indication of commercial success in that the market has recognized the novelty of the invention. However, the criteria for commercial success, as outlined in section 716.03 of the MPEP, depends on the following factors.

i) there is a nexus between the claimed invention and the evidence of commercial success. As per establishing a nexus, the affiant's averred statements speak to the accuracy of the present invention being the reason for the attainment of sole supplier of the State of Utah.

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ii) that the evidence of commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791 USPQ 294 (CCPA 1971). Although the nexus was addressed, the scope of the averred statements is not commensurate with the claims. The averred statements indicate “sufficiently accurate” and “reliable enough”, however, there is no evidence that the claimed “high degree of reliability in excess of 95% of matching”, “the quantity of matches to at least 96% for all insurance records [...] and the quality of computer matches is at least 99% for an overall system reliability of 95.8% of matching drivers/vehicles/policy” was involved in the alleged commercial success.

iii) the commercial success must be derived from the claimed invention. In order to establish commercial success, the evidence must show that the alleged commercial success is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy advertising, shifts in advertising, consumption by purchasers normally tied to the Applicant or assignee, or other business events extraneous to the merits of the claimed invention. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). In this case, it is not clear whether the State of Utah selected Applicant’s invention in a neutral market place in which they were free to choose without the influence of heavy advertising, shifts in advertising, consumption by purchases tied to Applicant/assignee, or other extraneous business events.

In the present case the affidavit evidence does provide a nexus as to the commercial success and the claimed invention. However, since the evidence is not commensurate in scope and does not provide does not rule out the marketing reasons for commercial success and is therefore insufficient to meet the requirements for establishing commercial success.



2) Affiant claims that “the invention provides the first statistically accurate lists, which are reliable enough to be accessed in real time for field use, and therefore meets the unexpected improved properties in the prior art.” However the criteria set forth for establishment of unexpected results in MPEP section 716.02 depends on establishing that the difference is really unexpected. Applicant must show that the results were greater than those, which would have been expected from the prior art to an unobvious extent, and that the results are a significant practical advantage. *Ex parte The Nutrasweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991).

In this case, the resulting accurate database of uninsured motorists comes from the computer processed, sorted and matched data inputs and updates to the databases. It is respectfully submitted that when computer processing, sorting, and matching is employed, accuracy is the desired result. Further, the prior art of Johnston cited in this case, clearly details instantaneous field use in that state troopers in Colorado use the “Explore Information Services of Red Wing, Minn.” to access a computer database to check insurance and can confiscate a license on the spot.” This establishes that the invention is not the first uninsured motorist list to be used in the field and thus be “reliable enough”. As such, the affidavit is insufficient in meeting the criterion for establishing unexpected results.

3) Affiant further argues that “nothing in the prior art cited suggests the uninsured motor vehicle methods/records were not sufficiently reliable for field use and therefore the references

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were improperly combined based on the Applicant's own disclosure." This argument as well as affidavit statements 6-15 repeat arguments addressed in sections A-H in this Office Action.

Further in regard to the affidavit, the Affidavit indicates that Insure-Rite's statistical sampling and additional data provide the accuracy required by state licensing agencies, and allowed them not to rely on insurance company's information, which was susceptible to fraudulent usage of forged insurance cards. However, Johnston solves the same problem evident by the mentioning of overcoming the same fraudulent usage of forged insurance cards with the "Explore" database. Although this meets the first requirement of Long-felt Need (MPEP 716.04) of having a persistent need that was recognized by those of ordinary skill in the art, it does not meet the second requirement that the long-felt need must not have been solved by another before the invention of the applicant. See *Newell Companies v. Kenney Mfg. Co.* 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). In addition, the affidavit does not provide any evidence of the failure of others in solving the long felt problem or of any unsuccessful attempts at meeting the long felt need. *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 217 USPQ 1281 (Fed. Cir. 1983). Further, the failure to solve a long felt need may be due to factors not addressed in the exhibits such as lack of interest or lack of appreciation of an inventor's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 196 USPQ 657 (1<sup>st</sup> Cir. 1977).

As per affiant statements 1-4, these points show Richard Kasteler's relationship to the application and to the art. As such, the affidavit appears self-serving in that the affidavit merely

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provides statements made by the President of the assignee. The Examiner is not sure how much weight can be attributed to the statements of the affidavit as such statements are neither positively and definitely confirmed or corroborated by a third party/objective affiant(s) or consumer(s) and because no other forms of hard evidence (i.e., graphs, charts, sample survey forms, official survey results) have been provided to evidence the averred statements and arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of non-obviousness fails to outweigh the evidence of obviousness.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon art teaches a computerized system that will allow an officer to check a driver's insurance during a traffic stop and confiscate the license if the driver is found to not have insurance (Sanko, John, "Uninsured Drivers May Lose License New Law Allows Officers to Confiscate Them On the Spot if Computer Shows Violation").

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**13. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

**(703) 305-7687** [Official communications]

**(703) 746-7238** [After Final communications, labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet D. Chance whose telephone number is (703) 305-5356.

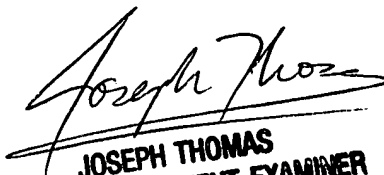
The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7687 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JDC  
December 2, 2002



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600